

## **REMARKS/ARGUMENTS**

In the Office Action mailed April 7, 2004, claims 1-24 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

I. The Examiner rejected claims 1-3 and 9-18 under 35 U.S.C. § 103(a) as being obvious over United States Patent No. 5,581,042 to Tambini (hereinafter referred to as "Tambini I") in view of United States Patent No. 4,845,998 to DeMartelaere *et al.* (hereinafter referred to as "DeMartelaere").

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142.

Applicants respectfully point to the final prong of the test, which states the prior art must teach all the claim limitations. Applicants note that the Examiner in each rejection under this section has consistently stated that "it would have been obvious to one of ordinary skill in the art at the time the invention to combine the teachings" of all the cited references. The Examiner does not point to any suggestion or motivation in the references themselves to support such a finding. In fact, the Examiner at one point combines four references to sustain the obviousness

rejection. Applicants respectfully note that the fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In fact, it appears from the rejections and cited references that the Examiner has used hindsight reconstruction to arrive at the claimed invention. “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In rejecting each of the independent claims 1, 9, 12 and 16, the Examiner cited the combination of Tambini I and DeMartelaere. Initially, Applicants note that claim 9 has been cancelled and has been replaced by the claim 25.

In each of these claims, Applicants has claimed either a housing or a means for enclosing, which is configured to be positioned a tool and a fastener. The housing includes among other things a shaft or a means for applying torque and a angle rate sensor or means for measuring angle rotation. All of these elements are contained within the housing or means for enclosing.

Applicants note that at the least, the references do not teach the aspect of a housing or enclosure that is positioned the tool and the fastener. Furthermore, the cited references do not teach a single compact housing having a shaft is linked to an angle rate sensor such that the speed and direction of the torque applied is measured such that the desired angle of rotation is achieved.

One advantage of the present invention is that the housing or means for enclosing contains all the components necessary to measure the angle of rotation. Another benefit of the

present invention is that it can be used with a mechanic's existing tools and does not require a special set of tools. In other words, the present invention can be used with any off the shelf digital multimeter or digital automotive tester.

Furthermore, the device is capable of fitting into smaller more compact places. This could not be accomplished with the prior art, especially the Tambini I reference. Some other benefits is that the prior art references do not disclose an angle rate sensor linked to the shaft such that it measures the speed and direction of the torque.

The combination of the Tambini I and Demartelaere references do not contain all the claimed features of the present invention. At the very least, the references do not teach or disclose the using of a housing in which are the components are location. Furthermore, the display device as disclosed DeMartelaere is a dedicated display that can only be used in conjunction with the fastener drive head assembly 12 (See DeMartelaere col. 5, lines 1-34). This deficiency of either of the references is not cured by the combination of the other.

Applicants respectfully request that in light of the above arguments, the obviousness rejection be removed and claims 1-3 and 9-18 be allowed to pass to issuance.

II. Claims 4 and 23 are rejected under 35 U.S.C. § 103(a) as being obvious over Tambini I in view DeMartlaere in further view of United States Patent No. 6,609,407 to Tambini (hereinafter referred to as "Tambini II"). Claim 4 depends from an claim 1, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Claim 23 ultimately depends from claim 16, an allowable independent claim and therefore any claim from which it

depends is allowable as well. Applicants respectfully request that the obviousness rejection to claims 4 and 23 be removed.

III. Claims 5 and 24 are rejected under 35 U.S.C. § 103(a) as being obvious over Tambini I in view DeMartelaere and further view of Tambini II and Japanese Patent No. 07205042A to Honda. Claim 5 depends from an claim 1, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Claim 24 ultimately depends from claim 16, an allowable independent claim and therefore any claim from which it depends is allowable as well. Applicants respectfully request that the obviousness rejection to claims 5 and 24 be removed.

IV. Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being obvious over Tambini I in view of DeMartelaere and in further view of United States Patent No. 5,095,746 to Stanis (hereinafter referred to as “Stanis”). Claim 6 ultimately depends from an claim 1, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Claim 20 ultimately depends from claim 16, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Applicants respectfully request that the obviousness rejection to claims 6 and 20 be removed.

V. Claims 7 and 21 were rejected under 35 U.S.C. § 103(a) as being obvious over Tambini I in view of DeMartelaere and further in view of Stanis and United States Patent No. 4,308,779 to Suzuki (hereinafter referred to as “Suzuki”). Claim 7 ultimately depends from an claim 1, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Claim 20 ultimately depends from claim 16, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Applicants respectfully request that the obviousness rejection to claims 7 and 21 be removed.

VI. Claims 8 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of DeMartelaere and in further view of United States Patent No. 5,571,971 to Chastel *et al.* (hereinafter referred to as “Chastel”). Claim 8 ultimately depends from an claim 1, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Claim 22 ultimately depends from claim 16, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Applicants respectfully request that the obviousness rejection to claims 8 and 22 be removed.

VII. Claim 19 was rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of DeMartelaere and in further view of United States Patent No. 6,345,436 to Codrington (hereinafter referred to as “Codrington”). Claim 19 depends from an claim 16, an allowable independent claim, and therefore any claim from which it depends is allowable as well. Applicants, therefore, respectfully request that the rejection to this claim be removed.

## CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the objections and rejections made in the outstanding Office Action. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1703 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out be telephone.

In the event this paper is not time filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036, with reference to our docket number 87355.3000.

Respectfully submitted,

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